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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,870	10/15/2003	Thomas J. Laginess	IN-5698	7421
26922	7590	10/17/2006		
BASF CORPORATION 1609 BIDDLE AVENUE WYANDOTTE, MI 48192			EXAMINER BERMAN, SUSAN W	
			ART UNIT	PAPER NUMBER

1711

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/686,870	LAGINESS ET AL.	
	Examiner	Art Unit	
	Susan W. Berman	1711	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): objection to claim 9; 35 USC 112 rejection of claim 14.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-20.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached page.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: see Notice of References cited attached hereto.

Susan W Berman
 Primary Examiner
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Response to Arguments

Applicant's arguments filed 09-28-06 have been fully considered but they are not persuasive.

Applicant's arguments with respect to significant figures are unpersuasive for the following reasons. Applicant's range of 0.1 (0.0 to 0.2 taking significant figures into account) to 0.95% (0.94 to 0.96) includes wt percents between 0.0 % and 0.96 % while the range from 1% (0 to 2%) to 8% (7 to 9%) disclosed by Fenn et al includes 0% to 9% according to the rules of significant figures. Therefore, there is overlap between 0.0 and 0.96 % by weight of photoinitiator between the disclosure of Fenn et al and the range set forth in applicant's claims. Applicant has not provided any evidence to show that limiting the amount of photoinitiator to 0.95% or less provides unexpected results.

Furthermore, the following patents teach that acylphosphine oxides or benzyl ketal kinds of photoinitiators are known to be effective in amounts below 1 % in compositions comprising acrylate-functional components. Garnett et al (6,162,511) disclose radiation curable compositions comprising acrylated compounds and pigments and, preferably, from 0.1 to 15 parts by weight photoinitiator (see column 1, line 61, to column 2, line 27, column 3, lines 26-56, and column 9, lines 5-18). Blatter et al (6,432,491) disclose UV curable water-thinnable binders comprising acrylated compounds and 0.1 to 5 wt. % photoinitiator such as benzoin derivatives or acylphosphine oxides (column 3, lines 3-21 and lines 49-59, column 4, lines 21-32, and Example 2). Awokola et al (6,605,669) disclose coating compositions comprising acrylated compounds and 0.1 to 7 weight percent of a photoinitiator such an acylphosphine oxide (column 8, lines 8-22, and Example 4). Okada et al (6,844,029) disclose primer coating compositions comprising

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acrylated urethane compounds and 0.01 to 20 parts by weight of a photoinitiator such as a benzylketal or an acylphosphine oxide (column 7, line 46, to column 8, line 44).

Applicant argues that the combination of a low photoinitiator concentration and natural light is highlighted in Example 3 (0.19% photoinitiator by weight of primer composition). The data in Example 3 and Table 3, said to demonstrate adhesion and humidity resistance benefits obtained by using natural light, has been considered. This data is unpersuasive of patentability for the following reasons. It is not clear to the examiner what composition was used to obtain the data in table 3. Paragraph [0035] refers to coatings prepared according to example 2 and cured under one of the conditions set forth on page 10. This description is followed by Example 3 "Primer Cured in Outdoor Natural Light" and then by Table 3. However, it is not clear which composition, Example 2 or Example 3, has been tested to obtain the data in Table 3. The exposure time using UVA/B/C lamp is not given. The post humidity adhesion and 25 hour recovery adhesion values do not appear to be significantly different. There is no comparison example representative of the teaching of the cited prior art, wherein the composition contains 1.00% photoinitiator compared with an example of the instantly claimed composition containing 0.95% photoinitiator. In any case, the data presented is not commensurate in scope with the instant claims, which recite wt% ranges for each component, including 0.1 to 0.95% photoinitiators.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W. Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SB
10/10/06


Susan W Berman
Primary Examiner
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